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09/459,202

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YUKIKAZU MORI

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9787

7590

05/20/2005

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EXAMINER

LEE, TOMMY D

| ART UNIT | PAPER NUMBER |
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2624

DATE MAILED: 05/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/459,202

Applicant(s)

MORI, YUKIKAZU

Examiner

Thomas D. Lee

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

1. This Office action is responsive to applicant's amendment filed December 16, 2004. Claims 1-33 are pending.

2. Claims 27 and 28 were preceded with the identifier "currently amended." However, these claims are identical to previously-presented claims 27 and 28. Therefore, it is assumed that applicant intends no changes to these claims.

### ***Claim Rejections - 35 USC § 103***

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 1, 2, 5, 6, 9-14, 18-20, 21/(9-14, 18-20), 22, 25/14 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,052,445 (Bashoura et al.) in view of U.S. Patent 6,437,871 (Yuki).

Regarding claim 1, Bashoura et al. teach a network facsimile device for communicating in at least one of a plurality communication modes for transmitting designated image information to a designated destination, said device comprising: input means for operator input of information identifying a plurality of destination addresses, including for each destination a plurality of address information respectively corresponding to said plurality of communication modes, and for designating one address among said plurality addresses to which the document image information is to be transmitted (column 3, line 63 - column 4, line 7; column 4, lines 15-20 (programming a table to store information inherently requires an operator to input the

information intended to be stored)); and address information registering means for registering a plurality of address information respectively corresponding to said plurality of communication modes, input by the operator through said input means, for each destination (column 4, lines 8-20).

Scanner means for scanning a document and outputting document image information is provided in a local fax machine 1 connected to fax director 3 (Fig. 1). While the scanner means, input means and address information registering means are not located in a single device, such a limitation is disclosed in Yuki. Scanner means 2, input means (panel operation portion 1) and address information registering means (memory portion 5) are located within the facsimile apparatus shown in Fig. 1 of Yuki (column 3, lines 29-53). Since all of the components are provided in a single device, portability is enhanced; and a single device may be contained in a smaller area, thereby saving floor space. Therefore, it would have been obvious for one of ordinary skill in the art to modify the teaching of Bashoura et al. by combining the local fax machine, fax director and local computer in a single housing, such as disclosed in Yuki.

Bashoura et al. do not teach display means, wherein, when said input means is repeatedly operated at the time of designating the address, a plurality of address information registered are changed over and viewed on said display means in order, as recited in claim 2, or one-touch dial means for enabling a large number of addresses to be registered and to designate the one address by operating the one-touch dial means, as recited in claims 5 and 6. Yuki teaches a facsimile apparatus having a display means for displaying a plurality of registered address information stored in one-touch dial

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memory (column 5, lines 51-57; column 6, lines 54-59). When one of the destinations is specified by operation of the panel operation portion, a copy operation begins (column 5, lines 56-60; column 6, lines 59-64). By providing a one-touch dial operation, a user may save time in dialing numbers that are frequently used, since only one key corresponding to the telephone number or IP address need be pressed. Therefore, it would have been obvious for one of ordinary skill in the art to modify the teaching of Bashoura et al., by providing a one-touch dial memory such as taught by Yuki. Repeated operation of input means is merely a scrolling operation for changing addresses or modes of operation on a display, which is well known in the art. Regarding claim 9, Bashoura et al. teach a network facsimile device comprising: Internet image information communicating means for performing communication of image information through the Internet (column 2, lines 51-56); and public network image information communication means for performing communication of the image information through a public network, wherein said Internet image information communication means and said public network image information communicating means communicate information to a plurality of designated destinations (column 2, lines 56-61); input means for inputting information identifying a plurality of addresses and for designating one address among said plurality of addresses (column 3, line 63-column 4, line 7); and address information registering means for registering a plurality of address information respectively corresponding to said Internet image information communicating means and public network image information communicating means, for each designated destination (column 4, lines 8-20).

As mentioned above with respect to claim 1, it would have been obvious for one of ordinary skill in the art to modify the teaching of Bashoura et al. by combining the local fax machine, fax director and local computer in a single housing, such as disclosed in Yuki.

Regarding claims 10 and 11, Bashoura et al. teach a network facsimile device comprising: electronic-mail type Internet image information communicating means for performing communication of the image information through the Internet by use of electronic mail (column 4, lines 27-38); real-time type Internet image information communicating means for performing communication of the image information through said Internet in real time (column 4, lines 21-26, 34-38); and public network image information communicating means for performing communication of the image information through a public network (column 2, lines 56-61), wherein either one of said electronic- mail type Internet image information communicating means, said real-time type Internet image information communicating means, and said public network image information communicating means communicate information to a plurality of designated destination addresses (column 4, line 43 – column 5, line 13); and input means for inputting information identifying a plurality of addresses and for designating one address among said plurality of addresses (column 3, line 63 – column 4, line 7); and address information registering means for registering a plurality of address information respectively corresponding to said electronic-mail type Internet image information communicating means, said real-time type Internet image information communicating means, and said public network image information communicating means, for each

designated destination (column 4, lines 8-20). Said plurality of registered address information include an e-mail address for use by said electronic-mail type Internet image information communicating means, an IP address for use by said real-time type Internet image information communicating means, and a telephone number for use by said public network image information communicating means (Fig. 4).

Scanner means for scanning a document and outputting document image information is provided in a local fax machine 1 connected to fax director 3 (Fig. 1). While the scanner means, input means and address information registering means are not located in a single device, such a limitation is disclosed in Yuki. Scanner means 2, input means (panel operation portion 1) and address information registering means (memory portion 5) are located within the facsimile apparatus shown in Fig. 1 of Yuki (column 3, lines 29-53). Since all of the components are provided in a single device, portability is enhanced; and a single device may be contained in a smaller area, thereby saving floor space. Therefore, it would have been obvious for one of ordinary skill in the art to modify the teaching of Bashoura et al. by combining the local fax machine, fax director and local computer in a single housing, such as disclosed in Yuki.

As mentioned above with respect to claim 1, it would have been obvious for one of ordinary skill in the art to modify the teaching of Bashoura et al. by combining the local fax machine, fax director and local computer in a single housing, such as disclosed in Yuki.

Claims 12-14 each recite the display means of claim 2, and thus are rejected for the reasons set forth above.

As mentioned above with respect to claim 2, Bashoura et al. do not teach repeatedly operating the same key at the time of designating the address, thereby changing over and selecting, in order, a plurality of address information registered in said key (claims 18-20 do not recite display means, and is thus not rejected in view of Yuki). However, repeated operation of input means is merely a scrolling operation for changing addresses or modes of operation on a display, which is well known in the art. Providing a key for changing and selecting address information in order would have been an obvious modification for one of ordinary skill in the art, for it allows a user to save time in changing address information. Accordingly, claims 18-20 are rejected for the reasons set forth above with respect to claim 2.

Claims 21 and 25 each recite the one-touch dial means of claims 5 and 6, and thus are rejected for the reasons set forth above.

Claim 22 recites the features of above-rejected claim 10, and further recites the repeated operation of input means similarly recited in claim 20, and is thus rejected, for the reasons set forth above.

Regarding claim 32, the one-touch dial means disclosed in Yuki, as mentioned above with respect to claims 5 and 6, enables operator use of said input means to designate one of the addresses registered for a destination to which the document image information is to be transmitted, and the document image information is transmitted to the designated address.

5. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bashoura et al.



Claim 26 is a method claim corresponding to above-rejected apparatus claim 22. The method steps of the claim are either disclosed or would have been obvious in view of Bashoura et al. (note above rejections of claims 10 and 20, as well as claim 22). Note that the method claim does not require the scanning operation as well as the other operations to be performed in a single device, and thus the step of scanning a document and providing document image information based on the scanned document is performed by the local fax machine of Bashoura et al. (scanning is a standard feature of fax machines).

6. Claims 31 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bashoura et al. as applied to claim 26 above, and further in view of Yuki.

As mentioned above, claim 31 recites the one-touch dial means of claims 5 and 6, and thus is rejected for the reasons set forth above. The one-touch dial means enables operator designation of one of the mail address, the IP address and the telephone number registered for a destination associated with said key; and transmitting the document image information to the address designated by the operator.

7. Claims 3, 4, 7, 8, 15-17, 21/(15-17), 23, 24, 25/(15, 23, 24), 29 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bashoura et al. in view of Yuki and U.S. Patent 5,381,527 (Inniss et al.).

Regarding claim 3, Bashoura et al. do not teach setting each of a plurality of address information registered by said address information registration means with a transmission priority indicating an order in which communication modes are to be used for transmitting the designated image information to the designated destination, as

recited in claim 3. Inniss et al. teach a system for efficient message distribution, wherein methods of communicating messages are prioritized (column 3, line 33 – column 4, line 5). By prioritizing the communication modes, the transmitting of any type of message may be performed with greater efficiency. A user may know which destinations are capable of operating under certain modes of communication, and may prioritize based on such knowledge so as to avoid possible errors in transmission. Thus, it would have been obvious for one of ordinary skill in the art to modify the teaching of Bashoura et al. by providing means for setting a priority order for communicating messages, such as taught by Inniss et al.

Claim 4 further recites repeatedly operating the same key at the time of selecting the address, thereby changing over and selecting plural address information registered on said key in accordance with said transmission priority order. As mentioned above with respect to claim 2, repeated operation of input means is merely a scrolling operation for changing addresses or modes of operation on a display, which is well known in the art. Providing a key for changing and selecting address information according to a priority order would have been an obvious modification for one of ordinary skill in the art, for it allows a user to save time in changing priorities for each destination.

Claims 7 and 8 each recite the one-touch dial means of claims 5 and 6. As mentioned above, Yuki teaches a facsimile apparatus having a display means for displaying a plurality of registered address information stored in one-touch dial memory (column 5, lines 51-57; column 6, lines 54-59). When one of the destinations is

specified by operation of the panel operation portion, a copy operation begins (column 5, lines 56-60; column 6, lines 59-64). By providing a one-touch dial operation, a user may save time in dialing numbers that are frequently used, since only one key corresponding to the telephone number or IP address need be pressed. Therefore, it would have been obvious for one of ordinary skill in the art to modify the combined teaching of Bashoura et al. and Inniss et al., by providing a one-touch dial memory such as taught by Yuki.

Claims 15-17 each recite the setting means of claim 3, and are thus rejected for the reasons set forth above.

As mentioned above, claims 21 and 25 recite the one-touch dial means of claims 5 and 6, and thus are rejected for the reasons set forth above.

Claim 23 recites the features of above-rejected claim 10, and further recites registering respective transmission priority orders for each of said mail address, said IP address, and said telephone number; wherein either one of said electronic-mail type Internet image information communicating means, said real-time type Internet image information communication means, and said public network information communicating means is selected in accordance with the transmission priority order respectively registered with said mail address, said IP address, and said telephone number, for image information transmission to the address selected by operation of said input means. As mentioned above with respect to claim 3, Inniss et al. teach a system for efficient message distribution, wherein methods of communicating messages are prioritized (column 3, line 33 – column 4, line 5). By prioritizing the communication

modes, the transmitting of any type of message may be performed with greater efficiency. A user may know which destinations are capable of operating under certain modes of communication, and may prioritize based on such knowledge so as to avoid possible errors in transmission. Thus, it would have been obvious for one of ordinary skill in the art to modify the teaching of Bashoura et al. and Yuki by providing means for setting a priority order for communicating messages, such as taught by Inniss et al.

Claim 24 recites most of the features of claim 23, and further recites repeated operation of input means, thereby changing over and selecting plural addresses in accordance with a transmission priority order. As mentioned above with respect to claim 4, providing a key for changing and selecting address information according to a priority order would have been a obvious modification for one of ordinary skill in the art, for it allows a user to save time in changing priorities for each destination. Accordingly, device claim 24, as well as corresponding method claim 28, is rejected.

Claims 29 and 30 each also recite the one-touch dial means of claims 5 and 6, and thus are rejected as well, for the reasons set forth above.

8. Claims 27 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bashoura et al. in view of Inniss et al.

Claims 27 and 28 are method claims corresponding to above-rejected apparatus claims 23 and 24, respectively. The method steps of the claims are either disclosed or would have been obvious in view of Bashoura et al. and Inniss et al. (note above rejections of claim as well as claims 23 and 24). Note that the method claims do not require the scanning operation as well as the other operations to be performed in a

single device, and thus the step of scanning a document and providing document image information based on the scanned document is performed by the local fax machine of Bashoura et al. (scanning is a standard feature of fax machines).

### ***Response to Arguments***

9. Applicant's arguments filed in response to the prior rejection of claims 1-31 as set forth in the Office action of October 6, 2004 have been fully considered but they are not persuasive.

Applicant asserts that neither Bashoura et al. nor Yuki disclose a facsimile apparatus wherein a user is presented with a choice of plural communication modes, and thus do not disclose or suggest a network facsimile device including input means for operator designation of one address among the plurality of addresses associated with a desired destination to which the document image information is to be transmitted (page 23, line 8 – page 24, line 26 of applicant's amendment). However, it should be noted that the claim recites operator selection of an address, not a communication mode (claim 1 recites "input means ... for designating one *address* among said plurality of *addresses* ... (emphasis added)). This limitation is suggested by the combined teachings of Bashoura et al. and Yuki, as mentioned above.

Applicant asserts that no disclosure or suggestion is found in the cited prior art of a network facsimile device which comprises each of the limitations recited in claim 1 (page 25, lines 6-20 of applicant's amendment). This amounts to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. The claim

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limitations are suggested in the combined teaching of Bashoura et al. and Yuki, as mentioned in the rejection of claim 1 above. As for independent claims 9, 10, 22-24 and 26-28, applicant asserts that these claims are patentable over the cited art for at least similar reasons as independent claim 1 (page 25, lines 21-24 of applicant's amendment). However, claim 1 is not patentable, for the reasons set forth above. Thus, it follows that none of the other independent claims are patentable, either.

### ***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas D. Lee whose telephone number is (571) 272-

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7436. The examiner can normally be reached on Monday-Friday (7:30-5:00), alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (571) 272-7437. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Thomas D. Lee  
Primary Examiner  
Art Unit 2624

tdl  
May 17, 2005